

REMARKS

This is in response to the Office Action mailed November 8, 2002, in the above-referenced application. The rejections of record are addressed below in the order presented in the Office Action.

Applicants submit concurrently herewith a second Declaration under 37 C.F.R. §1.131. Applicants respectfully submit that the Rule 131 Declaration presented with the response filed September 11, 2002 is sufficient to overcome the rejection based on the Stinson patent. Applicants, however, present the second Declaration to assist the Office in its analysis and to advance prosecution of this matter.

As stated in paragraph 3 of the second Declaration, the inventors prepared the claimed composition in accordance with the process described at page 13, line 30 to page 14, line 7 of the present application. The sample was evaluated to determine the presence or absence of sigma secondary particles. A copy of a laboratory report with the results of the analysis is attached as Exhibit A. The report and accompanying memo (Exhibit B) confirm that the sample did not include second phase particles. Figures 3 and 4 of the present application further support this finding. Figures 3 and 4 are photomicrographs of the sample and also demonstrate the absence of secondary phase particles.

Applicants respectfully submit that the evidence of record establishes that the inventors conceived and reduced to practice the claimed invention prior to the filing date of the Stinson patent. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claims 17-22 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicants respectfully traverse this rejection.

Claims 17-22 recite a composition of a biocompatible cobalt-base alloy comprising chromium and molybdenum, said alloy being essentially free of carbide, nitride, and sigma phase particles. Carbide, nitride and sigma phase particles are all discrete and measurable components typically found in traditional alloys. See Figures 1 and 2 of the present application, which demonstrate the presence of carbide, nitride and sigma phase particles in a traditional alloy.

In contrast, these components are not present in the composition of the claimed invention. Figures 3 and 4 of the present application demonstrate the absence of such particles in Applicants' claimed invention.

The application demonstrates that one of ordinary skill in the art would understand the meaning of the terms objected to by the Office. The application also demonstrates that one of ordinary skill in the art would understand how to evaluate an alloy sample to determine the presence or absence of such particles.

Claims 17-22 define the composition in terms of the absence of such particles, not in terms of specific properties of the present invention. This claim technique is permissible. MPEP § 2173.05(i). Applicants accordingly respectfully request withdrawal of this rejection.

In view of the arguments presented herein, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. If any minor informalities need to be addressed, the Examiner is directed to contact the undersigned attorney by telephone to facilitate prosecution of this case.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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